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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,475

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Brian D. Andresen

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7590

12/17/2003

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EXAMINER

ROGERS, DAVID A

ART UNIT

PAPER NUMBER

2856

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/917,475

Applicant(s)

ANDRESEN ET AL.

Examiner

David A. Rogers

Art Unit

2856

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 18 and 20 (see continuation page).
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


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Continuation of 3:

Claim 18 would be allowable if rewritten in independent form and incorporating all intermediate claims.

Claim 20 would be allowable if rewritten in independent form and incorporating all intermediate claims. Furthermore, applicant is request to amend claim 20 to require that, when an open end tube is selected (see claim 10 lines 5-6), the diameter of the open end is smaller than the particulate size. This is required so that the particulate matter does not fall out of the needle when an open end is selected.

Continuation of 5. does NOT place the application in condition for allowance because: The applicant argues that there is no teaching, suggestion, or incentive/motivation in Berg or Pawliszyn which suggests the desirability of providing the perforations of Pawliszyn along the length of the hollow needle of Berg. This argument suggests that the motivation must come from the cited prior art. This is incorrect. The suggest or motivation to combine references must come from the prior art or be commonly known. See MPEP 2143.01 "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art" and "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art". The final rejection set forth states:

"It is also well known and understood in the art of sampling probes that sheaths are used to protect a sensitive member from damage due to exposure to moving media such as an agitated solution, or to other environmental concerns such as thermal shock. It is also very well known that such protective sheaths are provided with holes, perforations, or apertures in order to increase the amount of sample that the sensitive member is exposed to while also ensuring that the sensitive member is not damaged during use."

Berg teaches a SPME needle with a coating on its inner surface. Pawliszyn teaches that it is known to provide shields for coated fibers where the shield has a plurality of holes along its length. Pawliszyn also teaches "[t]he shield contains various perforations 110 and a main opening 112 to allow access of the fluid carrier (not shown)". Clearly, Pawliszyn teaches that there is motivation to provide holes in that it allows better acces to the coating on the fiber by the fluid. Therefore, the prior art teaches that it is known to provide holes to better the circulation of the fluid and its contact with the coating. Also, one of ordinary skill in the art generally knows that the use of holes in a tube exposed to a media that is being sensed increases the probability that the sensing will be successful. Many gas-type sensor utilize perforated shields to protect the active sensor portion. Therefore, it would only involve routine skill in the art to provide holes on the needle of Berg in order to increase the media circulation and media exposure to the coating on the inner surface of the needle. Berg does not need the additional "protective shield" as the coating is on the needle itself, and the needle provides the protection not otherwise provided for in the prior art that utilize thin fibers with coatings for SPME. See also United States Patent 6,039,923 to Klemm et al. (not previously cited) where a sampling tube (reference item 802) that comprises an absorbant and a plurality of holes (reference item 808) is used to sample air.

The applicant argues that by providing holes on the needle of Berg, one would divert the flow from the tip and, therefore, reduce the flow through the tip. A substantial portion of the needle is inserted into the media to be sampled, as shown in Figure 2 of Berg. Doing so would eliminate any flow losses due to the holes, as argued by the applicant. Even though Figure 1 shows only a portion of the needle inserted into the gas chromatograph, one of ordinary skill in the art would know to insert the needle until all holes were inside the chromatograph.

The applicant argues that there is no suggestion to modify the teachings of Pawliszyn with the teachings of Berg. This is a spurious argument as the rejection made involved modifying Berg with the teachings of Pawliszyn, not Pawliszyn in view of Berg. There is nothing in the MPEP, patent rules, or patent law that requires that a claim rejected using references A in view of B also require that B in view of A be enabled.